

10/016,001

T075A

REMARKS

Claims 1-4 are currently pending in the subject application and are presently under consideration. Claims 5-15 have been withdrawn pursuant to a restriction requirement, and are hereby cancelled. New claims 16-23 have been added herein to more completely emphasize certain novel aspects of the present invention. No new matter has been added that would necessitate further substantive searching and/or examination. A complete listing of claims in revised amendment format is located at pages 2-4. Favorable reconsideration of the subject patent application and entry of the new claims is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-2, 3, and 4 Under 35 U.S.C. § 103(a)

Claims 1-2, and 3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hudetz, *et al* (U.S. Patent No. 5,978,773) in view of Powell (U.S. Patent No. 5,887,271).

Withdrawal of this rejection is respectfully requested for at least the following reasons.

Hudetz, *et al*. alone or in combination with Powell does not teach or suggest applicants' claimed invention. Moreover, Powell teaches away from being combined with Hudetz, *et al*.

A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). Furthermore, a reference that teaches away from the art is a *per se* demonstration of a lack of *prima facie* obviousness. *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997). A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir. 1994); *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

Applicants' invention as recited claim 1 is neither taught nor suggested by Hudetz, *et al*. alone or in combination with Powell. As conceded by the Examiner, Hudetz, *et al*. does not disclose providing demographic information about a consumer to a product manufacturer by

10/016,001

T075A

utilizing an information inquiry as recited in claim 1. Powell fails make up for the deficiency of Hudetz, *et al.* Claim 1 recites in pertinent part providing an associated web site address to a computing device of a consumer for allowing the consumer to make a *product information inquiry* to said web site address, and providing demographic information about the consumer to a product manufacturer by *utilizing the information inquiry*. In contrast, Powell teaches providing demographic information to a manufacturer only after a purchase has been completed and a coupon has been redeemed, rather than when a customer is *inquiring* or seeking information about a product that they may or may not ultimately purchase. Additionally, Powell provides demographic information to manufacturers only after the consumer completes a lengthy written application, an electronic card is obtained from a bank, and the electronic card is ultimately used in conjunction with a purchase (See col. 6, lines 60-63). The subject claimed invention provides demographic information based on the information inquiry itself not on use of an electronic card and consumer entered demographic information.

In addition, applicants' representative disagrees with the Examiner's statement that "The customer demographic data is sent to a manufacturer when the customer uses the card to request product information." Product information, limited to product appearance and location, is provided to the customer at a kiosk not at the checkout (col. 4, lines 50-54). However, the kiosk is not connected to the Internet and does not send customer data to the manufacturer. Moreover, applicants' representative submits that a reference merely disclosing transfer of demographic data by way of the Internet would not suggest to one skilled in the art the claimed method of providing manufacturers with demographic data about a consumer utilizing an information inquiry. Thus, Powell fails to provide the missing teaching or suggestion of providing demographic information about the consumer to the product manufacturer by *utilizing the information inquiry*, as recited in claim 1.

Moreover, Powell teaches away from being combined with Hudetz, *et al.* Claim 1 recites, in part, providing the associated web site address to a computing device of the consumer for allowing the consumer to make a product information inquiry to said web site address, and providing demographic information about the consumer to the product manufacturer by utilizing the information inquiry. Powell teaches away from being combined with Hudetz, *et al.* at least because the reference teaches away from using the Internet or an intranet for product inquiry. Rather, Powell teaches storing programs, product information, and product images on CD-ROM,

10/016,001

T075A

a static read-only storage device (See col. 9, lines 50-54 and Fig. 10). As such, when a customer inserts their card into a kiosk the CPU retrieves and displays information directly from the CD-ROM related to each product for which the cardholder has a coupon (not necessarily all the products they would like to inquire about). Moreover, Powell teaches that it is best to store information on CD-ROM, because the contents of the CD-ROM tend to remain current for at least several months (See col. 9, lines 54-57). Subsequently, a new CD-ROM can "preferably" be obtained from a national supplier (col. 9, lines 57-58) when the contents of the current CD-ROM become stale. Therefore, Powell fails to make up for the aforementioned deficiencies of Hudetz, *et al.* with respect to claim 1. Furthermore, in view of the teachings of the references, there would be no reason why a person of ordinary skill in the art, without knowledge of the subject application, would consult the particular combination of references suggested by the Examiner. Accordingly, claim 1 is allowable and withdrawal of the rejection thereto is respectfully requested.

Claims 2-4 depend directly from claim 1. Claim 1 is allowable for at least the aforementioned reasons. By virtue of their dependency, claims 2-4 contain all the limitations of allowable independent claim 1. Accordingly, claims 2-4 are allowable for at least the same reasons as claim 1 from which they depend.

II. Rejection of Claim 4 Under 35 U.S.C. §103(a)

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Hudetz, *et al* and Powell as applied to claim 1 above, and further in view of Kaplan (U.S. Patent No. 5,963,916). Withdrawal of this rejection is respectfully requested for at least the following reason.

As discussed *supra*, the primary reference Hudetz, *et al.* alone or in combination with the secondary reference Powell, fails to teach or suggest all limitations recited in independent claim 1. Furthermore, Powell teaches away from such combination. Kaplan, fails to make up for the deficiencies of the primary and secondary references. Accordingly, claim 4 (which depends from claim 1) is allowable and withdrawal of this rejection is respectfully requested.

10/016,001

T075A

III. New Claims 16-23

Claims 16-23 have been newly added herein to emphasize various novel features of the subject invention. It is respectfully submitted that the limitations recited in these claims are neither disclosed nor suggested in the reference alone or in combination. Accordingly entry and allowance of these claims is respectfully requested.

IV. Conclusion

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin
Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731